

## **REMARKS**

Claims 1 and 8-26 are pending in the application.

By the foregoing Amendment, claims 1, 8, 9, 10, 11, 13, 15, 17, 23, and 25 are amended.

These changes are believed not to introduce new matter, and entry of the Amendment is respectfully requested.

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

### **Objection to the Claims**

In paragraph 3 of the Office Action, claim 26 was objected to as being of improper dependent form. This objection is believed to be overcome by the above amendment to claim 25.

### **Rejection under 35 U.S.C. § 112, ¶ 2**

In paragraph 4 of the Office Action, claims 1, 8-11, 13, 15, 17, 20, 23, and 25 were rejected under section 112, second paragraph, for indefiniteness. This rejection is believed to be overcome by the above amendments to claims 1, 8, 9, 10, 11, 13, 15, 17, 23, and 25.

Applicant thanks the Examiner for her suggestion regarding amendments to the claims to overcome the rejection, in order to clarify that Applicant intends a collective meaning of “warp” and “weft.” It is respectfully submitted that when read in light of the specification, as indeed the claims must be, it is clear that “warp” and “weft” are used in their collective sense to mean all the filaments

in the warp and all the filaments of the weft; and that amendment of the claims is not necessary to clarify their meaning.

Nonetheless, in order to advance prosecution, Applicant has amended the claims substantially along the lines suggested by the Examiner, with slight modifications in order to ensure that: (1) with respect to claims 1, 8, 11, 13, 15, 17, 23, and 25, it is understood that the original meaning of “at least one of ... and ...” is retained and (2) with respect to claims 9 and 10, the original meaning of “one of ... and ...” is retained. It is respectfully submitted that when interpreted in light of the specification, the scope of the claims has not been changed by the amendments made to overcome the rejection under section 112, second paragraph.

#### Rejections under 35 U.S.C. § 103

##### 1. Claims 11, 13, 15, and 17

In paragraph 6 of the Office Action, claims 11, 13, 15, and 17 were rejected under section 103(a) as being unpatentable over Ellis. To the extent the Examiner considers this rejection to be applicable to the claims as amended, it is respectfully traversed as being based on a reference that neither teaches nor suggests the claimed invention.

Claims 11 and 15 recite a fabric article woven of monofilaments having a diameter of 70 micrometers or less, while claims 13 and 17 recite an article in which the monofilaments have a diameter of 30 to 70 micrometers. As noted in the Office Action, Ellis teaches a woven fabric which incorporates a gold wire having a diameter of 0.1 to 0.5 mm.

It is respectfully submitted that the Office Action does not make out a *prima facie* case of obviousness, because there is no overlap in the diameter dimensions of the invention as recited in claims 11, 13, 15, and 17 and the fabric taught by Ellis. Ellis's diameter of 0.1 to 0.5 mm converts to 100 to 500 micrometers (see the attached printouts of the conversions from the WWW Unit Converter, [www.digitaldutch.com/unitconverter](http://www.digitaldutch.com/unitconverter)), an order of magnitude different from the diameter range required by the present claims.

The Office Action attempts to dismiss this lack of overlap by characterizing diameter as a "result effective variable." Not only does such an approach ignore the requirements for a case of *prima facie* obviousness; but also it is logically inconsistent with the refusal to give any patentable weight to the type of article recited in the preambles of the claims, inasmuch as the "result" of "result effective variable" is not determined in a vacuum but is inextricably tied to the purpose of the article to which the variable is being applied.

Ellis is directed to teaching the inclusion of a medically safe metallic material in an otherwise conventional prosthesis woven (both warp and weft) from a polyester yarn (see European Patent Application 0 126 520, which is discussed by Ellis at page 1, and a copy of which is submitted herewith for the Examiner's reference). More particularly, Ellis teaches that preferably one, and at most four gold wires are included "as a single end weaving in the same heald on the loom as one of the main warp yarns of a ligament prosthesis as described in European Patent Application 0 126 520." As Ellis goes on to explain: "Such gold wire is of sufficient diameter to be identifiable in a X-ray photograph of a bone, yet of sufficiently low diameter to be reasonably flexible for the purposes of weaving." In other words, Ellis's teaching relating to diameter requires striking a

balance between sufficient thickness to be identifiable in an X-ray and sufficient thinness to be reasonably flexible for purposes of weaving. This is a different “result” than that sought by the present invention, which is a diameter suitable for weaving a fabric in which the entire warp and/or the entire weft is made of a gold alloy metal monofilament. *See In re Antonie*, 559 F.2d 618, 620 (CCPA 1977) (holding that the overall efficiency of a wastewater treatment device was not the same parameter as the efficiency of the “treatment contactor” within the device, and hence the prior art did not recognize efficiency of the “treatment contactor” as a result-effective variable).

In fact, Ellis actually *teaches away* from the claimed invention, inasmuch as Ellis implies that a diameter of less than 0.1 mm (100 micrometers) would result in a gold wire too thin to be identifiable in an X-ray. The Federal Circuit has stated that a *prima facie* showing of obviousness can be overcome by showing “that the art in any material respect taught away from the claimed invention.” *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997).

Further, Ellis does not teach a fabric in which the entire warp and/or the entire weft is made of a gold alloy metal monofilament, as in the present invention. As mentioned above, Ellis merely teaches the inclusion of a single gold wire (or at most, four gold wires) “as a single end weaving in the same heald on the loom as one of the main warp yarns of a ligament prosthesis as described in European Patent Application 0 126 520.”

Finally, claims 11 and 15 both recite that the gold alloy metal monofilament is 0.12 to 6.5 N in tensile strength. As recognized in the Office Action, Ellis does not explicitly teach anything about tensile strength. The Office Action glosses over this deficiency by stating that it is “reasonable to presume” that the recited monofilament tensile strength would be inherent in Ellis. As support

for this presumption, the Office Action cites “the use of like materials (i.e. a gold alloy wire woven fabric with a diameter of 70 micrometers or less).”

This aspect of the rejection is fatally, logically flawed because, as pointed out above, Ellis does not teach or in any way suggest the use of like materials. Ellis teaches a gold monofilament with a diameter an order of magnitude greater than that recited in the claims. Assuming for the sake of argument the relationship posited in the Office Action between diameter and tensile strength, the gold wire taught by Ellis must inherently have a tensile strength above the range recited in claims 11 and 15.

In view of the foregoing, it is respectfully submitted that Ellis does not teach or suggest the invention as recited in claims 11, 13, 15, and 17, that the invention as recited in claims 11, 13, 15, and 17 is patentable over Ellis, and that the rejection should be withdrawn.

## 2. Claims 1, 2, 8, and 11-18

In paragraph 7 of the Office Action, claims 1, 2, 8, and 11-18 were rejected under section 103(a) as being unpatentable over Ellis in view of Ogasa. To the extent the Examiner considers this rejection to be applicable to claims 1, 8, 11, 13, 15, and 17 as amended, and the claims depending therefrom, it is respectfully traversed as being based on a combination of references that neither teaches nor suggests the claimed invention, for the reasons discussed above with respect to the rejection of claims 11, 13, 15, and 17.

Ogasa was cited only for its teachings relating to a process for producing high-purity hard gold alloys. Ogasa does not remedy any of Ellis’s defects as discussed above .

In view of the foregoing, it is respectfully submitted that Ellis and Ogasa in combination do not teach or suggest the invention as recited in claims 1, 2, 8, and 11-18, that the invention as recited in claims 1, 2, 8, and 11-18 is patentable over Ellis in view of Ogasa, and that the rejection should be withdrawn.

3. Claims 9, 10, and 19-26

In paragraph 8 of the Office Action, claims 9, 10, and 19-26 were rejected under section 103(a) as being unpatentable over the Tolmachoff article in view of JP 62078228A. To the extent the Examiner considers this rejection to be applicable to claims 9, 10, 23, and 24 as amended, and the claims depending therefrom, it is respectfully traversed as being based on a combination of references that neither teaches nor suggests the claimed invention

The Tolmachoff article says very little about *altabas* fabric, and Applicant's counsel has not been able to find any additional information. According to the Tolmachoff article, *altabas* is "a silk fabric in a twill weave with one and two wefts, one of which was a gold wire." As best as can be understood from this brief description, *altabas* is a two weft fabric, only one of which is made from a gold wire. The Tolmachoff article does not teach a fabric in which the entire warp and/or the entire weft is made of a gold alloy metal monofilament, as in the present invention, much less providing any teaching regarding the diameter of the gold wire.

JP 62078228A was cited as teaching gold threads formed of twisted gold wires having a diameter of 0.05 to 0.2 millimeters (50-200 micrometers). Although each individual wire has a diameter of 0.05 to 0.2 millimeters, as described in the abstract, these gold wires are twisted into a gold thread, which is used for decoration in knitted or woven fabrics; the gold threads are not

themselves used in weaving the fabrics. Furthermore, as shown in the drawings, these threads comprise at least three twisted gold wires, so even if the threads were used to weave fabrics, the filaments of the weft would not be monofilaments, as required by the claims; and the diameter of the actual threads would be at least 100-400 micrometers (the thread of Figure 2 would have a diameter slightly greater than that of one wire, so the diameter of the thread would be slightly more than double that of the diameter of one wire), an order of magnitude greater than the diameter recited in the claims.

Because neither of the references teaches or suggests like materials (contrary to the assertion in the Office Action), the presumption employed in the Office Action relating to prior art teachings of tensile strength must fail.

In view of the foregoing, it is respectfully submitted that the Tolmachoff article and JP 62078228A in combination do not teach or suggest the invention as recited in claims 9, 10, and 19-26, that the invention as recited in claims 9, 10, and 19-26 is patentable over the Tolmachoff article and JP 62078228A, and that the rejection should be withdrawn.

### Conclusion

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

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**Attachments:** European Patent Application EP 0 126 520  
Conversion of .1 mm to micrometers (using WWW unit converter)  
Conversion of .5 mm to micrometers (using WWW unit converter)